

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Peter M. Perthou
Serial No. : 09/752,015
Filed : December 29, 2000
Title : KEY RING

Art Unit : 3627
Examiner : Suzanne Lale Dino Barrett

Hon. Commissioner for Patents
Washington, D.C. 20231

RESPONSE B

Dear Commissioner:

Responsive to the office action dated January 28, 2002, reconsideration of the rejection of claims 1-11 is respectfully requested in the light of the following remarks and authorities.

1, 2. Claims 1, 2, 4, 6, 7, 9 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Chen as a primary reference in view of Jung as a secondary reference and Momemers as a tertiary reference. The primary reference is said to teach a flexible band member 16 having a keyring 12 attached to one end. The secondary reference is said to teach a key holder comprising an intermediate member between the member 11 and keyring 15 in the form of a D-ring having a V-shaped portion connecting one end of the band and the keyring. The D-ring is said to further comprise a gap portion to be attached to the band and a clip means said to be 20/21/22 to clamp the other end of the band together. The secondary reference is recognized as failing to teach a D-ring having a U-shaped portion. The tertiary reference is said to teach a similar keyring comprising a D-ring with a U-shaped portion 3. It is said it would have been considered an obvious matter of design choice to one of ordinary skill in the art to provide an intermediate member between the band and the keyring of the primary reference as said to be taught by the secondary reference since it is said to be well known in the keyring art to provide as many intermediate members as desired due to the ease of attaching multiple rings together and further substitute a U-shape for the V-shape D-ring of the secondary reference,

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since the varying shapes of rings are said to be well known and there is said to be criticality for the U-shape.

Furthermore, the method limitations of claim 11 are said to be considered inherent to the device of the primary reference as modified by the secondary and tertiary references.

With regard to claims 2, 4, 7 and 9, the primary reference is said to teach a web material for a keyholder 16. It is said it would have been obvious to one of ordinary skill in the art to modify the band of the secondary reference to be a flexible web material as said to be taught by the primary reference to be easier to handle and store.

This ground of rejection is respectfully traversed.

We set forth below authorities quoted in the response filed November 19, 2001, which were not mentioned in the office action dated January 28, 2002.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

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As the Federal Circuit Court of Appeals said in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999):

Close adherence to this methodology is especially important of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'

And in *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), the Court said:

[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* [*Dembiczak*]. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998), *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B. F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).

Nothing in the references remotely suggests the desirability of combining what is there disclosed to meet the terms of the rejected claims. Furthermore, the contention that it would have been "considered an obvious matter of design choice to one of ordinary skill in the art to provide an intermediate member between the band and keyring" of the primary reference as said to be taught by the secondary reference is a conclusion, not a proper reason for sustaining a rejection under Section 103.

In *In re Garrett*, 33 PTCJ 43 (BPA&I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

The rejection of method claim 11 as inherent to the device assembled from three references by hindsight is improper. "In the absence of the article in the prior art we find no basis for the conclusion that the manipulative steps of assembling the nonexistent article would be obvious." *Ex parte Rubin*, 127 U.S.P.Q. 286, 287 (Bd. of Appeals 1959).

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Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.¹⁵ This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."¹⁶ *In re Fritsch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

¹⁵ *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

¹⁶ *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

Accordingly, withdrawal of the rejection of claims 1, 2, 4, 6, 7, 9 and 11 as unpatentable over the primary reference in view of the secondary and tertiary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to associate each element in each rejected claim with corresponding elements in the references and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of the claims.

3. Claims 3, 5, 8 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the primary reference in view of the secondary and tertiary references as applied to claim 2 and further in view of Shelton as a quaternary reference. The quaternary reference is said to teach a keyholder comprising a band 10 having a U-shaped or V-shaped D-ring at one end and a clamp 20 for the other end of the keyholder band. It is said it would have been obvious to one of ordinary skill in the art to modify the clamp means 20/21/22 of the secondary reference by providing a clip type clamp as said to be taught by the quaternary reference as an obvious matter of design choice. This ground of rejection is respectfully traversed.

The reasoning set forth above in support of the patentability of claim 2 is submitted to support the patentability of claims 3, 5, 8 and 10 over the primary, secondary and tertiary references so that further discussion of the quaternary reference is submitted to be unnecessary. Furthermore, we have set forth above that the rejection based on an "obvious matter of design choice" is a conclusion, not a reason that supports a rejection under Section 103. Accordingly,

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withdrawal of the rejection of claims 3, 5, 8 and 10 as unpatentable over the primary, secondary, tertiary and quaternary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to associate each element in these claims with corresponding elements in the references, and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of these claims.

4. The authorities upon which we relied in the response to the office action dated July 18, 2001, are equally applicable to overcoming the rejection of claims on the new combination of references, with stronger reason because rejections are based on "an obvious matter of design choice," a conclusion, not a reason that was rejected by the Board in *Ex parte Garrett*, supra.

5. The courtesy of the Examiner in conducting an additional diligent search is acknowledged with appreciation. The prior art made of record and not applied has been examined and is submitted to be incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the foregoing authorities, reasoning and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, she is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what steps she believes are necessary to place the application in a condition for allowance.

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The Commissioner is respectfully requested to apply the \$460 fee for the Petition for Three-Month Extension of Time to Deposit Account No. 06-1050, Order No. 08914-009001.

Respectfully submitted,

FISH & RICHARDSON P.C.

JUL 29 2002

Date: _____



Charles Hieken
Reg. No. 18,411
Attorneys for Applicant

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

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